

## REMARKS

Claims 1-39 had been cancelled without prejudice or disclaimer. Claims 40, 49 and 59 are amended. Claims 40-59 are pending. No new matter has been added to the application by the present Amendment.

### **I. Objection To Claims 49-57:**

The Examiner objected to claims 49-57 and 59 and stated that “[i]t is not clear how information can be ‘partial access but not full access’ or ‘full access’ since information cannot be access.” The Examiner further stated that “[i]nserting ‘information’ or ‘level information’ after ‘full access’ would overcome the objection.” Claims 50-57 were objected to as being dependent on claim 49. In response, Applicant has amended claims 49 and 59 in the manner suggested by the Examiner. It is believed that this change to the wording in claims 49 and 59 does not change the scope or coverage of the claim. The change is made to comply with the Examiner’s request to overcome the objection.

In addition, the Examiner objected to claims 40, 49 and 59 as lacking antecedent basis for the phrase “the geographic location” because claim 40 had previously referred to a “general geographic location.” Claims 41-48 and 50-58 were objected to as being dependent on claims 40, 49 or 59. In response, claims 40, 49 and 59 are amended to delete the term “general,” thus providing antecedent basis for “the geographic location.” It is submitted that the removal of the term “general” does not narrow the scope of the phrase “geographic location,” (the phrase “a geographic location” can include a “general” geographic location and/or a “specific” geographic location).

Applicant requests that the objections to claims 41-59 be withdrawn.

### **II. Rejections of Claims Under 35 U.S.C. 102(e) and 35 U.S.C. 103(a):**

Claims 40, 41, 45-47, 49, 50, 54-56 and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,317,718 to Fano. Claims 40 and 49 are alternatively rejected

and claims 48 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,236,330 to Cohen. Claims 42-44 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,317,718 to Fano in view of the Examiner's Official Notices.

In addition, the Examiner has raised "alternate rejections" over U.S. Patent No. 6,009,116 to Bednarek et al. In particular, claims 40, 41, 43, 46-50, 52, and 55-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Bednarek et al. Claims 42, 44, 45, 51, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,009,116 to Bednarek et al. In addition, the Examiner proposed a further alternate rejection of claims 40-59 under 35 U.S.C. 103(a) as being unpatentable over Bednarek, where the Examiner states that "full patentable weight" is given "to the 'providing' step" in those claims.

In responding to Applicant's previous remarks, the Examiner argues that the claims (prior to the present amendments) were broad enough to deal with two instances, where 1) all the plural processors are within or 2) all are not within the predefined location or region, as alternatives (such that the Examiner applied alleged prior art to one, but not both of the alternatives). In particular, to apply all but the last rejection noted above, the Examiner stated that the claims are "interpreted that after the determining step, the prior art only needs to disclose either: 1) requiring additional information when within; or 2) providing access to the first information to the recipient processor, without requiring the additional info, when that processor has been determined to be outside the region." (Office Action, Section 5b.)

However, as amended, the claims recite "determining ... that ... each of one or more of the recipient processors ... is within a predefined location or region and determining that each of another one or more of the recipient processors ... is not within the predefined location or region." None of the references of record teach or suggest a method as recited in either claim 40, 49 or 59, including determining, from the location information, that the geographic location of each of one or more of the recipient processors from which the location information is recieved is within a predefined location or region and determining that each of another one or more of the

recipient processors from which the location information is received is not within the predefined location or region; and further either:

- a) requiring predefined additional information before providing each recipient processor determined to be within the predefined location or region access to first information; and providing each recipient processor not determined to be within the predefined location or region with access to first information without requiring the predefined additional information (as recited in claim 40); or
- b) requiring predefined additional information before providing each recipient processor determined to be within the predefined location or region access to first information; and providing each recipient processor not determined to be within the predefined location or region with access to second information without requiring the predefined additional information, wherein one of the first and second information is a partial access but not full access information to a product or service and the other of the first and second information is full access information to the product or service (as recited in claim 49); or
- c) requiring predefined additional information before providing each recipient processor determined to be within the predefined location or region access to first information; and providing each recipient processor not determined to be within the predefined location or region with access to second information without requiring the predefined additional information, wherein the first information is a partial access but not full access information to a product or service and the second information is full access information to the product or service (as recited in claim 59).

It is submitted that the claims, as amended, are patentably distinguished from the references of record. In addition, at least for reasons discussed in the Amendment and Reply filed December 11, 2008 (incorporated herein by reference), Applicant continues to reserve the

right to file additional evidence and comments in support of applicant's early date of invention (relative to the Fano and Cohen references), if needed. However, the claims are also believed to be patentably distinguished from the references applied in the rejections at least for other reasons discussed herein.

In the last listed rejection noted above, the Examiner argues that claims 40-59 are unpatentable over Bednarek under 35 U.S.C. 103(a), even when giving patentable weight to the "providing" step. (Office Action, Section 13.) This rejection is respectfully traversed.

In particular, the Examiner argues that "Official Notice is taken that promotional campaigns where products or services are given for free for limited periods are old and well-known to attract new customers." The Examiner further argues that "it would have been obvious to a PHOSITA to provide Benarek's 2<sup>nd</sup> information (full access content, to sports events, e.g., outside the event city) for free, for the same well-known promotional purposes, to attract new subscription customers."

However, while free give-aways are common promotional tactics, such common practices (even if considered with Bednarek) would not teach or suggest to one of ordinary skill in the art the method recited in either claim 40, 49 or 59. None of the references of record (including Bednarek) would have taught or suggested to one of ordinary skill in the art to apply free give-away programs in one set top box location, but require payment for the same information for set top boxes in another location.

For example, with regard to claim 40, a free give-away campaign would not teach or suggest "requiring predefined additional information before providing each recipient processor determined to be within the predefined location or region access to first information; and providing each recipient processor not determined to be within the predefined location or region with access to first information without requiring the predefined additional information."

Free give-aways are commonly offered to entice any potential customer. The Examiner's proposal that certain potential customers outside of an event city would be provided with full access to content for free without requiring payment information, while other customers inside of the city would be provided with content only upon payment, has no basis in the teachings of the prior art. Instead, the Examiner's proposal is based on hindsight derived from the present

application. If hindsight were not used, then a combination of a free give-away program with Bednarek's system would provide free information to any potential customer. It is beyond the teachings or suggestions of Bednarek to require additional information from customers in certain cities, but not require additional information from customers in other cities to access a particular content.

With regard to claim 49, Bednarek (even if considered with conventional free give-away campaigns) would not have taught or suggested a method requiring predefined additional information before providing each recipient processor determined to be within the predefined location or region access to first information; and providing each recipient processor not determined to be within the predefined location or region with access to second information without requiring the predefined additional information, wherein one of the first and second information is a partial access but not full access information to a product or service and the other of the first and second information is full access information to the product or service.

In addition to the distinctions noted above for claim 40, the Examiner's proposal for a free give-away does not address the further feature in claim 49 that one of the first and second information partial access (but not full access information) and the other is full access information. Accordingly, claim 49 is further distinguished from Bednarek et al.

With regard to claim 59, Bednarek (even if considered with conventional free give-away campaigns) would not have taught or suggested a method requiring predefined additional information before providing each recipient processor determined to be within the predefined location or region access to first information; and providing each recipient processor not determined to be within the predefined location or region with access to second information without requiring the predefined additional information, wherein the first information is a partial access but not full access information to a product or service and the second information is full access information to the product or service.

In addition to the distinctions noted above for claim 40, the Examiner's proposal for a free give-away does not address the further feature in claim 59 that the first information is a partial access (but not full access information) and the second information is full access information.

A free give-away campaign would not involve providing partial access information to customers in a predefined location or area only upon providing additional information, but providing full access information to customers not in the predefined location or area without requiring additional information. While the Examiner proposes a scenario in which access to a sports event is given for free to customers outside of an event city (while customers within the event city would pay for access to that sports event), the Examiner's proposed scenario does not address the feature in claim 59 that the first information (to paying customers in the Examiner's scenario) is a partial access but not full access information to a product or service and the second information (given free in the Examiner's scenario) is full access information to the product or service. Accordingly, claim 59 is further distinguished from Bednarek et al. Similar comments apply to dependent claim 58 (which depends from claim 40).

Each of claims 41-48 is dependent on claim 40 and each of claims 50-57 is dependent on claim 49. Accordingly, at least for reasons discussed above with respect to independent claims 40 and 49, each of dependent claims 41-48 and 50-57 is patentably distinguished over the references of record. Furthermore, each of the dependent claims 41-48 and 50-57 recite additional features that further distinguish those claims from the references of record.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Re-examination and reconsideration of the application, as amended, are requested.

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